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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,168	07/30/2001	Jaime E. Garcia	001202	2203
26285	7590	10/19/2004		
KIRKPATRICK & LOCKHART LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222			EXAMINER SELF, SHELLEY M	
			ART UNIT 3725	PAPER NUMBER
DATE MAILED: 10/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/918,168	Applicant(s) GARCIA ET AL.	
	Examiner Shelley Self	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-41, 52-70 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 42-50, 71 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-41 and 52-68 is/are allowed.
- 6) ☒ Claim(s) 69, 70 and 72-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed on June 30, 2004 has been considered and an action on the merits follows.

Election/Restrictions

Newly submitted claim 71 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: *drawn to a planer combination having a retractable measuring device.*

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 71 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 72-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 72, all of the critical interrelationships have not been positively recited. For example, it is not clear how the means for removing and means for

adjusting relate to the base and the frame. The claim appears to be a catalogue recitation of elements.

With regard to claim 73, there is no antecedent basis for “the first rotatable spindle”, it is not clear what the rotatable spindle refers to and how the first rotatable spindle relates to the positively recited elements of the claim (i.e., its relationship to the base, frame means for moving, means for adjusting). The critical relationships between the elements of the claim have not been positively recited.

Regarding claims 74 and 75, the claims fail to positively recite the critical interrelationships between the means for indicating.

The claims should be reviewed for clarity, proper recitation of all critical interrelationships and antecedent basis concerns.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 69 and claim 72 as best as can be understood are rejected under 35 U.S.C. 102(b) as being anticipated by Liao (5,829,499). Liao discloses a planer (4) comprising: a base (20); a frame, a first and second support members/means for adjusting (fig. 5) attached to the base and movably supporting thereon a cutter head (fig. 4) for selective travel in a first direction toward the base and a second opposite direction; a top frame (fig. 6) attached to at least the first support

member; and a depth stop mechanism/means for stopping (fig. 6-8) attached to the top frame for selectively preventing travel of the cutterhead in the first direction beyond a pre-selected distance from the base, wherein the first support member is linked to the second support member (fig. 6-8) such that rotation of the first support member causes identical rotation of the second support member such that the cutterhead remains parallel to the base during height adjustment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liao (5,829,499) in view of Chang (6,315,014). Liao does not disclose an endless chain as a means to link the first and second support members. Chang teaches in a similar art, a planer having a vertically moveable cutterhead wherein the first and second support members are linked via a chain and gears/sprockets. Chang teaches this construction for the purposes of maintaining the cutterhead parallel to the base during movement. Because the references are from a similar art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Liao's linking mechanism (40) with a chain and gear/sprocket mechanism so to link the support members to ensure the cutterhead is moved parallel to the base. Accordingly, it would have been equally obvious to replace Chang's chain and sprocket/gear linkage with connecting rod (40) as taught by Liao for the reasons stated above.

Allowable Subject Matter

Claims 20-41 and 52-68 are allowed.

Response to Arguments

Applicant's arguments, filed June 30 have been carefully considered. In view of Applicant's remarks the previous rejection(s) of claims 20,22 and 37 have been withdrawn.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

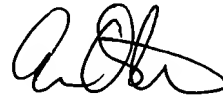
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (703) 305-5299. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's Supervisor, Allen Ostrager can be reached at (703) 308-3136. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIE or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf
October 14, 2004



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